Amendments to the Drawings:

The drawings were objected to for failing to comply with 37 CFR 1.84(p)(4) because reference character 13 had been used to designate both legs in FIG. 6 and the mushroom end in FIG. 8. Accordingly, applicants propose to correct FIG. 8 by deleting numeral "13" and substituting -- 22 -- therefor as shown in the annotated sheet. A replacement sheet is also submitted with this amendment and the Examiner's approval thereof is respectfully requested.

On page 2, paragraph 3, of the action, the drawings were objected to because reference character 17 in FIG. 9 was not mentioned in the disclosure. The disclosure is amended on page 10, line 4, to insert the reference numeral 17.

The disclosure and drawings should now be acceptable.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

Remarks

Claims 1, 4 and 17 are amended. Claims 2, 3 and 5 are cancelled and claims 19 and 20 are added. Claims 1, 4 and 6 to 20 are pending in this application of which claims 1, 4, 17, 19 and 20 are in independent form and claims 6 to 16 and 18 are withdrawn.

On page 2, paragraph 1, of the action, claim 17 was objected to because of the informality listed. Claim 17 is amended herein to make the required correction.

Claims 1 and 17 were rejected under 35 USC 102(b) as being anticipated by Koch et al (192). The following will show that claim 1, as amended, patentably distinguishes the applicants' invention over this reference.

Koch et al (192) is directed to a non-attached monitoring assembly for a pneumatic tire. Here, the monitoring assembly is placed within the tire but is not connected to the tire or tire rim and instead the monitoring assembly is allowed to move about freely inside the tire.

In contrast to Koch et al (192), applicants provide a transponder arrangement wherein a substrate and the transponder embedded therein are connected via a connecting structure to the inner side of the tire. This feature is set forth in claim 1 with the clause:

> "a connecting structure disposed between said substrate and said inner side of said tire for connecting said substrate to said inner side and supporting said substrate in spaced relationship to said

inner side;"

There is no suggestion anywhere in Koch et al (192) which could lead our person of ordinary skill to this feature and limitation so that claim 1 should now patentably distinguish the applicants' invention over this reference.

Claim 17 parallels claim 1 in the context of a combination claim directed to the tire per se so that this claim too should now be allowable.

Claims 1 to 3 and 17 were rejected under 35 USC 102(b) as being anticipated by Hahn et al.

Hahn et al has a United States filing date of January 17, 2003 which is later in time than the September 18, 2002 date on which German patent application 102 43 441.7 was filed and on which priority is claimed herein. Accordingly, applicants respectfully request that Hahn et al be withdrawn in accordance with 37 CFR 1.55. A verified translation of German patent application 102 43 441.7 was filed on February 17, 2006.

Claim 1 was rejected under 35 USC 102(a) and 35 USC 102(b) as being anticipated by Japanese patent publication JP 2001-308741 (hereinafter "Japan 741"). The following will show that claim 1, as amended, patentably distinguishes the applicants' invention over this reference.

As can be seen especially in FIG. 1 of this reference, the transponder arrangement is in essence a substrate. As shown, the transponder is disposed in the silicone resin layer 3 which is sandwiched between sheets 4 and 5 of silicone resin. There is no separate connecting piece for connecting the substrate to the

inner side of a tire in the manner set forth in applicants' claim 1 with the clause:

> "a connecting structure disposed between said substrate and said inner side of said tire for connecting said substrate to said inner side and supporting said substrate in spaced relationship to said inner side;"

In the applicants' invention, the substrate is a separate element which is connected to the inner side of a tire by the connecting piece.

In view of the above, claim 1 should now patentably distinguish the applicants' invention over Japan 741 and be allowable.

Claims 4 and 5 were rejected under 35 USC 103(a) as being unpatentable over Japan 741 in view of Pappas et al. Claim 4 is now in independent form and added claim 20 replaces claim 5.

The deficiency of Japan 741 is discussed above and Pappas et al does not enable our person of ordinary skill to reach the applicants' invention as set forth in claims 4 and 20. Pappas et al was cited because of the use of silicone rubber foam to prevent damage due to bending tension, et cetera. However, Pappas et al is directed to an alarm system for monitoring pressurized vehicle tires and the silicone in Pappas et al is used to encase an antenna 152 which consists of a number of copper or similar wire coils. This bears no relationship to supporting a substrate on the inside wall of a pneumatic tire.

Accordingly, claims 4 and 20 should patentably distinguish the applicants' invention over this reference so that these claims should be allowable.

Claims 1 and 17 were rejected under 35 USC 103(a) as being unpatentable over Japanese patent publication JP 9-136517 (hereinafter "Japan 517") in view of Koch et al (065). The following will show that claim 1 patentably distinguishes the applicants' invention also over this combination of references.

In Japan 517, a transponder body 1A is mounted on a jointing 1B consisting of an elastic member. Here, there is no reference to a substrate but simply to exposed transponder components. In the action, the view is expressed is that it would have been obvious to use a transponder chip and antenna embedded in a substrate and reference is made to Koch et al (065). However, this secondary reference simply suggests encapsulating the component in encapsulating material such as shown in FIG. 6. This component is then attached to the wall of the pneumatic tire utilizing a cover 80.

There is no discussion in Koch et al (065) of a substrate but rather only of an encapsulation for components and utilizing a cover for holding them against the wall of a tire. Accordingly, there is no teaching here of embedding a transponder in a substrate which is in spaced relationship to the inner side of a tire wall via a connecting structure as set forth in applicants' claim 1. Accordingly, it is not seen how our person of ordinary skill could hit upon the special configuration shown in applicants' FIG. 1 by comparing Koch et al (065) to Japan 517. There is no thread here which ties the two references to each other. Where in Koch et al (065) or in Japan 517 would our person of ordinary skill hit upon the idea of providing a connecting structure for connecting a substrate while the

substrate is in spaced relationship to the inner side of the tire as set forth in applicants' claim 1?

For the reasons advanced above, applicants submit that claim 1 also patentably distinguishes their invention over the combination of Japan 517 and Koch et al (065) and should now be allowable as should claim 17 which parallels claim 1 in the context of a combination claim.

Claims 4 and 5 were rejected under 35 uSC 103(a) as being unpatentable over Japan 517 in view of Koch et al (065) and in further view of Kobe et al and optionally further in view of Pappas et al or Dominak et al.

With respect to Dominak et al, applicants note that this reference has a United States filing date of March 19, 2003 which is later in time than the September 18, 2002 date on which German patent application 102 43 441.7 was filed and on which priority is claimed herein. Accordingly, applicants respectfully request that Dominak et al be withdrawn in accordance with 37 CFR 1.55. The verified translation of the German patent application 102 43 441.7 was filed as noted above.

The deficiencies of Japan 517 in combination with Pappas et al were discussed above and the third reference, Kobe et al (065) does not contribute. This reference was cited because it teaches the use of an elastic polymeric material in the context of a patch for repairing articles such as a bicycle tire inner tube. This teaching is even further remote from the applicants' invention than Pappas et al and does not assist our person of ordinary skill to arrive at the applicants' invention as it is set forth in claims 4 and 20. It is not seen how the

teaching of the use of silicone adhesive to bond a patch can enable our person of ordinary skill to arrive at the applicants' invention in combination with Japan 517 and Pappas et al.

In view of the foregoing, applicants submit that claims 4 and 20 also patentably distinguish their invention over this combination of references.

Added claim 19 provides another independent definition of the applicants' invention and recites that the cushion support is a leg-like structure to provide increased decoupling between the transponder and the inner side of the tire and is therefore still farther away from the art of record.

Reconsideration of the application is earnestly solicited.

Respectfully submitted,

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Date: April 17, 2006

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FIG. 5

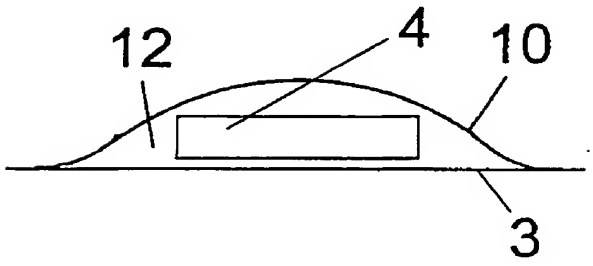


FIG. 6

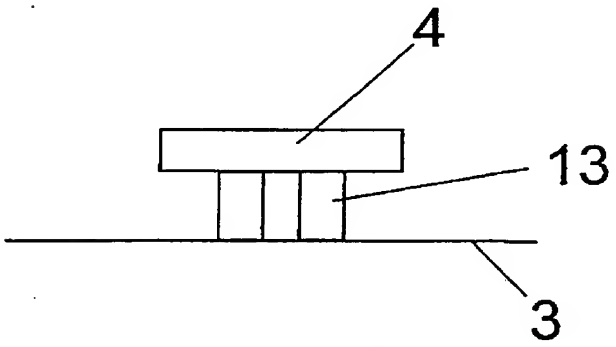


FIG. 7

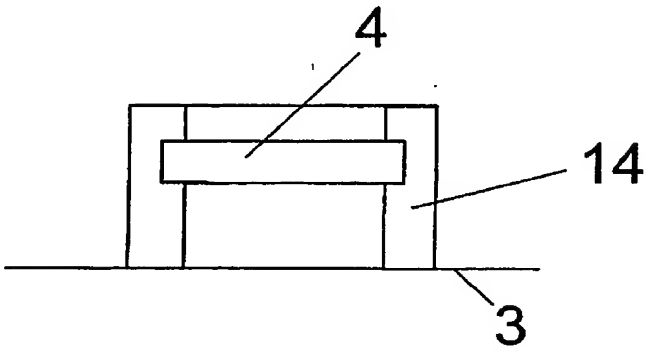


FIG. 8